

## **REMARKS/ARGUMENTS**

Reconsideration of this application is requested. Claims 24-30, 36, 37, 40 and 43-56 are in the case.

### **I. THE INTERVIEW**

At the outset, the undersigned wishes to thank the Examiner (Dr. Winkler) and her supervisor (Mr. Housel) for kindly agreeing to conduct a personal interview in this case. The interview was held on November 12, 2004, and was attended by Dr. Kenten, a co-applicant, and by the undersigned. The courtesies extended by the Examiner and her supervisor were most appreciated. The substance of the interview will be clear from the Interview Summary Record and the comments presented below.

### **II. THE FIRST 35 USC 112, FIRST PARAGRAPH, REJECTION**

Claims 24-30, 36, 37, 40 and 43 stand rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the written description requirement. As indicated in the Interview Summary Record, agreement was reached during the interview that this rejection will be withdrawn. Such action is respectfully requested.

### **III THE 35 USC 112, SECOND PARAGRAPH, REJECTION**

Claims 24-29, 36, 37, 40 and 43 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite in regard to the recitation of "method of reducing the level and/or activity of a target protein". Agreement was reached that this rejection will be overcome by reciting at the end of the main claims the language "wherein the level and/or activity of a target protein in the eukaryotic cell is reduced". This amendment has been made in the claims presented herewith. Withdrawal of the outstanding 35 U.S.C. §112, second paragraph, rejection is accordingly respectfully requested.

**IV     THE SECOND 35 U.S.C. §112, FIRST PARAGRAPH, REJECTION**

Claims 24-30, 36, 37, 40 and 43 stand rejected under 35 U.S.C. §112, first paragraph, on the ground that the specification, while being enabling for ubiquitination of a protein using a compound in a cell lysate assay system, allegedly does not reasonably provide enablement for ubiquitination of a compound within a cell and for the use of a compound as a pharmacological agent in a patient. This rejection is respectfully traversed.

As explained during the interview by Dr. Kenten, and the *in vitro* data in the specification leads to the expectation that the invention will work *in vivo*. Based on this expectation, the specification is enabling in that one of ordinary skill in this art would reasonably expect that the method would work in patients. Reconsideration and withdrawal of the outstanding lack of enablement rejection are accordingly respectfully requested.

**V     NEW CLAIMS**

The amendment to claim 24 simply restates the statement of intended result at the beginning of the claim and is thus supported thereby. New claims 44-56 presented herewith are similar to the existing claims in the application but are not limited to reduction of the level and/or activity of target protein in a eukaryotic cell. Basis for the new claims appears in the specification as follows:

New claim 44 is the same as claim 24 except that the reference to a eukaryotic cell is not present. Basis for this aspect of the claim appears at the end of the Example 1 at page 77 onwards in regard to cell lysates, where the method is clearly not

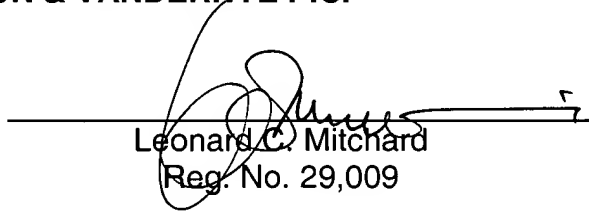
performed "in" a eukaryotic cell. Claim 45 is supported generally by the disclosure at page 10, beginning at line 3. Claim 46 is supported by the disclosure at page 34, line 10. Claim 47 is supported by the disclosure at page 19, line 26. Claim 48 is supported by the disclosure at page 34, line 16. Claim 49 is supported by the disclosure at page 20, line 3. Claim 50 is supported by the disclosure at page 19, line 25. Claim 51 is supported by the disclosure at page 20, line 4. Claim 52, 53 and 54 are supported by the disclosure at page 67, lines 1-7. Claim 55 is supported by the disclosure at page 20, lines 14-15 and page 29, lines 14-18. Claim 56 is supported by the disclosure at page 19, line 24-page 20, line 4. No new matter is introduced by the new claims presented with this response. Entry and favorable consideration of the new claims are accordingly respectfully requested.

Favorable Action on this application is awaited.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_

  
Leonard C. Mitchard  
Reg. No. 29,009

LCM:lfm  
1100 North Glebe Road, 8th Floor  
Arlington, VA 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100